

RECEIVED  
CENTRAL FAX CENTER

DEC 18 2006

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the specification to make the corrections noted by the Examiner.

In addition thereto, applicant has amended the specification to provide for the required section headings, and to avoid reference to specific claim numbers.

Applicant is also submitting a new Abstract to replace the Abstract that was originally filed, as requested by the Examiner. The new Abstract is written on a separate sheet as required.

The claims have been amended to provide for the corrections noted by the Examiner, and to rewrite them so that they meet the provisions of 35 U.S.C. 112.

In rejecting the claims over the two reference patents to Morr (6,792,903) and Baguena (4,572,118), the Examiner has listed elements which are present in the references and in the initial portions of the independent claims such as claim 28 (previously claim 11, now cancelled).

Thus, it appears that the Examiner has not taken into consideration the last portion of claim 28, for example, which reads "said point of inflection (W) being disposed so that a surface normal in a contact point at where maximum valve lift is achieved and substantially equal to a surface normal in said contact point where highest valve acceleration occurs."

This preceding limitation at the end of claim 28 is not to be found in either of the two references applied by the Examiner. This limitation in the claims distinguishes applicant's invention from the two prior art references applied above by the Examiner.

It is submitted that applicant provides for a new and marked improvement over the prior art.

Since the claims in the application define clearly the differences between applicant's invention and the prior art, it is believed that the claims should be found allowable.

The limitation noted above in claim 28, for example, is not only new but is inventive, and a person working in the art would not be inspired to arrive at applicant's invention.

The Examiner's attention is respectfully directed to the Court in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which the Court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

In the case of *ex parte Chicago Rawhide Manufacturing Company* (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of *The Standard Oil Company vs. American Cyanamid Company* (227 U.S.P.Q. 293), the court decided that the issue of obviousness is determined entirely with reference to a hypothetical person having ordinary skill in the art. It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventor's, as a class, according to the concepts underlying the constitution and the statutes that have created the patent system, possess something that sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under 35 U.S.C. 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive systematic research or by extraordinary insight; it makes no difference which.

Furthermore, in the case of *Uniroyal Inc. versus Rudkin-Wiley Corporation* (5 U.S.P.Q.2d 1434), the Court ruled that when prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness of making the combination.

The preceding decision is reinforced by *In re Dow Chemical Company* (5 U.S.P.Q.2d 1529), in which the Court decided that most technological advance is the fruit of methodical persistent investigation, as is recognized in 35 U.S.C. §103. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in

the art that this process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

In the case of United Merchants and Manufacturers Incorporated versus Ladd (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage of hindsight, one might offhandedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the reference discloses or suggests the concept which is the crux of the invention.

In the case of Panduit Corporation v. Burndy Corporation (180 U.S.P.Q. 498), the District court ruled that inquiry into patentability must be directed towards subject matter as a whole and not to elements of combination and their individual novelty; combination which results in a more facile, economical, or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that elements are individually old.

Finally, in the case of Meng and Driessen (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the amendments to the claims, specification and Abstract, and in view of the preceding remarks, it is

respectfully requested that the claims in the application be allowed and the case be passed to issue.

Respectfully submitted,

This Amendment is being  
transmitted by Fax  
to PTO on Dec. 18, 2006

*Max Fogiel 12/18/06*

By: *Max Fogiel*  
Max Fogiel  
44 Maple Court  
Highland Park, NJ 08904  
Phone: (732) 214-8892

c:\documents\fogiel\amendments\achon 542170 amendment 1 12-18-06